

Customer Number
00909



Application Serial No.: 09/750,302
Attorney Docket No.: 042846-0312814
Amendment Accompanying an RCE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S) : Andrew ROUSE *et al.* CONFIRMATION No.: 6724
SERIAL NUMBER : 09/750,302 EXAMINER : Kenneth Coulter
FILING DATE : December 29, 2000 ART UNIT : 2141
FOR : SYSTEM AND METHOD FOR PROVIDING CUSTOMIZABLE OPTIONS ON A
WIRELESS DEVICE

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Office Action mailed January 4, 2006, Applicant requests review of the final rejection in the above-identified application. This request is being concurrently filed with a Notice of Appeal. The review is requested for the reasons provided in the Remarks below. A total of 5 pages are provided.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 033975 (Ref. No. **042846-0312814**).

REMARKS

Claims 21-40 are all of the claims currently pending in the instant application. In the Office Action mailed January 4, 2006 (hereinafter "the 1/4/2006 Office Action"), the Examiner rejected claims 21-40 under 35 U.S.C. § 102(e) (1) as allegedly being anticipated by U.S. Patent No. 6,076,109 to Kikinis (hereinafter "Kikinis"), and (2) as allegedly being anticipated by U.S.

Patent Application Publication No. 2002/0024536 to Kahan *et al.* (hereinafter “Kahan”). These rejections are traversed on the following grounds.

In general, the disclosed invention relates to enabling a user to customize information that is received at and sent from a mobile device. *See* the specification at page 3. In some embodiments, information is formatted for transmission to the mobile device in a manner that corresponds to the display of the information on a desktop computer. In these embodiments, adjustments to the information must be made based on the capabilities of the mobile device, as well as the customization of the user. *See* the specification at pages 9 and 10.

I. Rejections based on Kikinis

Applicants traverse the rejection of claims 21-40 under 35 U.S.C. § 102(e) as allegedly being anticipated by Kikinis at least because Kikinis does not disclose all of the features of the claimed invention. For example, independent claim 21 recites a method of formatting content for a mobile wireless client device “based on a form that is used to display content on a desktop computer.” The method includes the features of “providing a mobile design element that corresponds to the form and is associated with the mobile wireless client device; [and] formatting the content according to the mobile design element.” Claim 36 recites a storage medium for storing machine readable code that is executable to provide features similar to those cited above in claim 21. Claims 26 and 31 recite systems for formatting content for a mobile wireless client device that include subject matter similar to the subject matter of claim 21 provided above. Kikinis does not disclose at least these features. Among other things, these features enable the user receive information on the mobile wireless client device in a format similar to the format in which the information would be presented to the user on a desktop computer.

In the 1/4/2006 Office Action, the Examiner asserts without support that Kikinis discloses providing a mobile design element that corresponds to the form and is associated with the mobile wireless client device at the Abstract and FIGS. 3 and 4. The Abstract appears to merely give a broad discussion of a proxy Internet server that is adapted to provide enhanced web-browsing capabilities to portable computers. This discussion does not include any description of a mobile design element, as defined by these claims. FIGS. 3 and 4 illustrate an exemplary session-script between a hand-held computer, a proxy-server, and a WEB server. *See* Kikinis at col. 4, lines

3-9. However, Kikinis does not disclose that the session-script corresponds to a form that is used to display content on a desktop computer. For at least this reason the rejection of claims 21, 26, 31, and 36 is improper and should be withdrawn.

Further, claims 22-25, 27-30, 32-35, and 37-40 depend from, and add features to, corresponding ones of claim 21, 26, 31, and 36. Therefore, the rejection of these claims should be withdrawn based on their dependency, as well as for the features that they add to the independent claims. For example, claims 23, 28, 33, and 38 include the feature of customizing the form according to settings selected on the mobile wireless client device. The Examiner cites Kikinis at the Abstract and FIGS. 3 and 4 as disclosing this feature. *See* the 1/4/2006 Office Action at page 5. As was stated above, these portions of Kikinis at best describe providing Internet content to hand-held computers using a session script. The cited sections do not disclose a form used to display content on a desktop computer, much less the customization of the form according to settings selected on a mobile wireless client device. For at least this reason, the rejection of these claims is improper and should be withdrawn.

As another example, claims 25, 30, 35, and 40 include the feature of generating the mobile design element based on the form. The Examiner alleges that Kikinis discloses this feature at the Abstract, FIGS. 3 and 4, and col. 9, lines 7-41. *See* the 1/4/2006 Office action at page 5. As has been discussed above, the Abstract and FIGS. 3 and 4 of Kikinis do not even disclose a form as defined by these claims, much less the generation of a mobile design element based on such a form. At column 9, lines 7-41, Kikinis appears to describe the use of a "NanoBrowser" on a hand-held computer to access boot up processes such as web-browsing and email. As with the other cited sections of the reference, column 9, lines 7-41 does not describe a form used to display content on a desktop computer. Nor does this section disclose the generation of a mobile design element based on such a form. For at least this reason the rejection of these claims is improper and should be withdrawn.

Other differences between claims 21-40 and Kikinis exist.

II. Rejections based on Kahan

Applicants traverse the rejection of claims 21-40 under 35 U.S.C. § 102(e) as allegedly being anticipated by Kahan at least because Kahan does not disclose all of the features of the

claimed invention. For example, independent claim 21 recites a method of formatting content for a mobile wireless client device “based on a form that is used to display content on a desktop computer.” The method includes the features of “providing a mobile design element that corresponds to the form and is associated with the mobile wireless client device; [and] formatting the content according to the mobile design element.” As is discussed above, claims 26, 31, and 36 include similar subject matter, among other things. Kahan fails to disclose at least these features of the claimed invention.

In the 1/4/2006 Office Action, the Examiner asserts without support that Kahan discloses providing a mobile design element that corresponds to the form and is associated with the mobile wireless client device at the Abstract, FIGS. 3 and 4, and paragraph 115. *See* the 1/4/2006 Office Action at page 6. From these references, it appears that the Examiner is implying that the subscriber provisioning profile of Kahan is analogous to the mobile design element. However, subscriber provisioning profile of Kahan appears to be used solely for formatting content for display on a mobile terminal, and these passages and drawings do not disclose that the subscriber provisioning profile of Kahan corresponds to a form that is used to display content on a desktop computer. For at least this reason, this rejection of claims 21, 26, 31, and 36 are improper and should be withdrawn.

Further, claims 22-25, 27-30, 32-35, and 37-40 depend from, and add features to, corresponding ones of claim 21, 26, 31, and 36. Therefore, the rejection of these claims should be withdrawn based on their dependency, as well as for the features that they add to the independent claims. For example, claims 22, 27, 32, and 37 include the feature of a mobile design element that comprises at least one of a document style sheet, a view style sheet, a pre-formatted page, or a script. The Examiner relies on Kahan at FIGS. 5 and 7, and paragraphs 52 and 59 for a disclosure of this feature. *See* the 1/4/2006 Office Action at page 7. But neither the description nor drawings cited by the Examiner actually discloses that the subscriber provisioning profile includes one of the listed elements. For at least this reason the rejection of claims 22, 27, 32, and 37 is improper and should be withdrawn.

As another example, claims 23, 28, 33, and 38 include the feature of customizing the form according to settings selected on the mobile wireless client device. The Examiner cites Kahan at the Abstract and paragraphs 51 and 53 as disclosing this feature. *See* the 1/4/2006

Office Action at page 7. At best the cited portions of Kahan discuss the customization of the subscriber provisioning profile. The cited sections do not disclose a form used to display content on a desktop computer, much less the customization of the form from a mobile wireless client device. For at least this reason the rejection of these claims is improper and should be withdrawn.

As yet another example, claims 25, 30, 35, and 40 include the feature of generating the mobile design element based on the form. The Examiner alleges that Kahan discloses this feature at the Abstract, and paragraph 115. See the 1/4/2006 Office action at page 7. As has been discussed above, the Abstract and paragraph 115 of Kahan do not even disclose a form as defined by these claims, much less the generation of a mobile design element based on such a form. For at least this reason the rejection of these claims is improper and should be withdrawn.

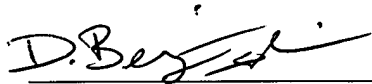
Other differences between claims 21-40 and Kikinis exist.

CONCLUSION

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Dated: April 4, 2006

Respectfully submitted,



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